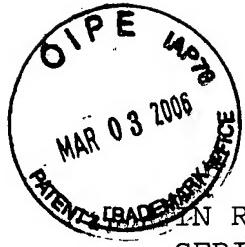


AF  
JFW

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: Mark W. Thompson  
 SERIAL NO.: 10/784,056  
 TITLE: GUARD FOR A GRASS TRIMMING DEVICE  
 FILED: February 20, 2004  
 Group/A.U.: 3724  
 Conf. No.: 6854  
 EXAMINER: Edward F. Landrum

Mail Stop Appeal Brief - Patents  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, VA 22313-1450

## APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 1-9 and 11-14 and 16 dated October 3, 2005.

## I. Real Party In Interest:

The real party in interest of the instant appeal is Mark W. Thompson an address of 12286 Sycamore Road, Ottumwa, Iowa 52501.

## II. Related Appeals and Interferences:

There are no related appeals or interferences.

## III. Status of the Claims:

Claims 1-9, 11-14 and 16 are pending in this application and appear as Appendix A of this brief.

## CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this document and the documents referred to as enclose therein are being deposited with the United States Postal Service as First Class mail addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, Alexandria, VA 22313-1450, on this 284<sup>th</sup> day of February 2006.

03/06/2006 TBESHAK1 00000006 10784056

01 FC:2402

250.00 OP

Timothy J. Zarley

IV. Status of Amendments:

No amendments to the claims have been made since the final rejection of February 8, 2005.

V. Summary of Claimed Subject Matter:

Independent claim 1 relates to a guard 10 for a grass trimming device 12 having a shaft 14 with a trimming head 16 at one end and a handle 18 at the opposite end. (Page 3, lines 3-6). The guard 10 also has a support member 20 that is slidably connected to the shaft with a releasable clamp 22. (Page 3, lines 8-13). The guard 10 also has a guard member 24 that extends outwardly from the second end of the support member 20 to deflect grass clippings projected from the head of the grass trimming device. (Page 3, lines 14-21).

Independent claim 6 is similar to independent claim 1 though claim 6 does not require that the support member be slidably connected to shaft 14 and instead requires the support member 20 be slidably connected within the releasable clamp 22 (Page 3, lines 7-25). Additionally, claim 6 requires a flexible brush member 24 connected to and extending outwardly from a second end of the support member 20 to detect grass clippings projected from the head 16 of the grass trimming device 12. (Page 3, lines 14-21). Claim 6 also adds the limitation of a means 22 for adjusting the distance between the guard member 24 and the shaft 14. (Page 3, lines 22-25). Furthermore, claim 6 requires that the flexible brush member 24 is positioned at a 90 degree angle to the shaft 14. (Pages 3, lines 18-21).

Independent claim 11 requires a guard 10 for a grass trimming device 12 having an elongated shaft 14 with a grass trimming head 16 at one end and a handle 18 at an opposite

end. (Page 3, lines 3-6). This guard comprises a support member 20 connected to the shaft 14 at a first end. (Page 3, lines 7-13). The guard 10 also has a flexible brush member 24 connected to the second end of the support member 20 to deflect grass clippings projected from the head 16. (Page 3, lines 14-18). Additionally, the flexible brush member 24 is positioned at a 90 degree angle to the shaft 14. (Page 3, lines 18-21).

VI. Grounds of Rejection to be Reviewed on Appeal:

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Watkins (U.S. Pat. No. 6,324,765). Claims 1, 3-9, 11-14 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Blevins (U.S. Pat. No. 6,327,782) in view of Wright (U.S. Pat. No. 5,107,665) in further view of Bridgers (U.S. Design Pat. No. 373,712). Applicant respectfully traverses the rejections.

VII. Argument In Support of Reversal

1. Rejection under 35 U.S.C. § 102.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Watkins. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing *In re Robertson*, 169

F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 1 in part requires "a support member slidably connected within the releasable clamp". Watkins does not teach this limitation as Watkins teaches a telescoping arm 4 attachable to a trimmer shaft with a clamp 5. (Col. 2, lines 50-55). As shown in the Figures, the connection between clamp 5 and telescoping member 4 is rigid. The telescoping arm 4 at one end receives an inner arm section 13 that is slidably received within the telescoping arm 4. (Col. 2, lines 67 - Col. 3, line 4). However, the inner arm 13 does not slide within clamp 5. Thus each and every limitation of claim 1 is not met by the Watkins reference and the anticipation rejection is considered overcome. Additionally claim 2 depends on claim 1 and for at least this reason is also considered to overcome the anticipation rejection.

## 2. Rejection under 35 U.S.C. § 103.

Claims 1, 3-9, 11-14, and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Blevins in view of Wright, and further in view of Bridgers. An obviousness

analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher."

Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's

disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

The obvious rejection asserted by the Examiner is based on a combination of prior art references, e.g., the grass trimmer having a flexible brush guard combined with the slidable clamping means on a shaft of Wright and the two parallel support members of Bridgers. To justify this combination the Examiner states "It would have been obvious to have modified Blevins to incorporate the teachings of Wright and Bridgers to create a guard means firmly supported to the clamp on the shaft by two support members. Slidable support members would allow user to incorporate larger or

smaller trimming radiiuses when using the trimming apparatus. Two sliding support members would provide added structural rigidity to the system and would help prevent the support arms and sliding apparatuses from getting bent due to gear member running into a rock or any other hard object." However, the Examiner has not pointed specifically to these references to show where the references expressly provide this motivation.

Wright teaches a device 20 that has a rigid block 28 that is secured to an arm 36 via slots 60 so that the arm 36 may slide via the slot. (Col. 6, lines 5-31). Specifically the block 28 that is attached to the shaft of the trimmer 24 is described as rigid and therefore Wright teaches non-movement of a block or clamping element along a shaft. Thus there would be no motivation to combine Wright with a reference such as Blevins to create a clamp that slides along a shaft. Similarly, Blevins teaches a skirt-like protective structure 20 that is secured to a shield 16 that can possibly be attached to the shaft via a bracket means 39. (See Col. 2, lines 36-43 and Col. 3, lines 47-51). Thus Blevins teaches not moving the skirt 20 in regards to the protective shield 16. Thus there would not be motivation to combine Blevins with a device that caused movement of the shield 16.

At best the prior art suggests two separate ways of moving an implement that is attached to a shaft of a weed trimmer. The prior art does not teach or contemplate having two different adjusting means associated with a single weed trimming device. The only way based on the teachings of the prior art, to arrive at the claimed invention, is to use the claim as a frame, taking individual, naked parts of separate prior art references where employed as a mosaic to recreate a facsimile of the claimed invention. W.L. Core & Associates

v. Garlock, Inc., 721 F.2<sup>nd</sup>, 1540, 1552 (Fed. Cir. 1983). At no point does the Examiner explain why the mosaic would have been obvious to one skilled in the art, or what would have caused those skilled in the art to disregard that each reference only provides a single adjusting means.

Thus Applicant asserts that the Examiner has succumbed to hindsight reconstruction by combining through the prior art to find teachings on the various aspects of the claimed invention, and declaring the claimed invention obvious in light of those references. In In re Fine, the Federal Circuit specifically warned against such "picking and choosing among isolated disclosures in the prior art falling victim to the insidious effect of a hindsight syndrome". 837 F.2<sup>nd</sup> at 1075. To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of the record convey or suggest the knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W. L. Gore, 721 F.2<sup>nd</sup> at 1553.

Even if there is a motivation to combine the prior art references, the combination would not provide each and every limitation of the cited claims.

The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be

considered in judging the patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 in part requires "a support member slidably connected within the releasable clamp". None of the three references teach this limitation. The reference to Blevins teaches a protective shield 16 that can be mounted on a bracket means 39. (Col. 3, lines 46-51). However, Blevins does not teach a slidable connection between the bracket means 36 and the shield 16.

Wright does not cure Blevins. Specifically, Wright teaches a rigid element 28 that is secured to the hollow tube 22 of trimmer 24. (Col. 4, lines 21-24). The rigid element 28 has a pair of bolts 62 that are displaced therein wherein the bolts 62 are received by a slot within the holding arm 36. (See Col. 6, lines 5-31). Thus the device 20 slides about the bolts 62. The device 20 however does not slide within the rigid block 28 and instead slides on bolts 62 that are attached to the rigid block 28. Thus Wright does not teach a support member that is slidably connected within the releasable clamp.

Bridgers additionally does not cure Blevins nor Wright as Bridgers is a design patent that teaches rigid L-brackets that are attached to a clamp member and these rigid L-shaped members do not appear to slide. Thus Bridgers does not teach a support member that is slidably connected within the releasable clamp.

As discussed above none of the prior art references cited by the Examiner teach a support member slidably connected within a releasable clamp as defined by claim 1. Therefore, each and every limitation of claim 1 would not be present when the prior art references cited are combined and therefore Applicant considers claim 1 not obvious.

Independent claim 6 has an identical limitation and therefore is also considered non-obvious. Claims 2-5 depend on claim 1 and claim 7-9 depend on claim 6 and are thus also considered to overcome the obvious rejection.

Independent claims 6 and 11 contain the limitation "wherein the flexible brush member is positioned at a 90° angle to the shaft". None of the prior art references cited by the Examiner teach a flexible brush member that is positioned at a 90° angle to a shaft. Specifically Bridgers does not teach a flexible brush member and instead teaches a protective shield. See Figures. Wright does not cure Bridgers as Wright also does not teach a flexible brush member and instead teaches a spatial guide 20 having a roller 56. Blevins also does not cure Bridgers or Wright because Blevins teaches a flexible brush member that is at a 90° angle to a shield 16 and not the shaft. Thus, the brush member itself is not at a 90° angle to the shaft and therefore Blevins does not teach a flexible brush member that is positioned at a 90° angle to the shaft. The only way to arrive at the claimed invention would be to take the spatial member of Wright or the shield of Bridgers and replace them with the brush member of Blevins and keep the connection such that it is at a 90° angle regardless of the operation consequences of doing so. Applicant submits that this reconstruction to arrive at the claimed invention can only occur if Applicant's specification is used as a blueprint. Therefore each and every limitation of independent claims 6 and 11 are not taught by the prior art references and the claims are considered non-obvious. Claims 7-9 and 16 depend on claim 6 and claims 12-14 depend on claim 11 and thus are all considered to overcome the obvious rejection. Therefore in view of the above identified arguments, Applicant

respectfully requests the Board overturn the Examiner's rejections within the final rejection and submit a Notice of Allowance for all claims.

Reversal is therefore respectfully requested.

Conclusion

Any fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,



Timothy J. Zarley  
Reg. No. 45,253  
ZARLEY LAW FIRM, P.L.C  
Capital Square  
400 Locust Street, Suite 200  
Des Moines, IA 50309-2350  
Phone No. (515) 558-0200  
Fax No. (515) 558-7790  
Customer No. 34082  
Attorneys of Record

- JLH/bjs -

Attachment: Appendix

## APPENDIX

### VIII. Claims Appendix

1. (previously presented) A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end, comprising:  
a releasable clamp slidably connected to the shaft;  
a support member slidably connected within the releasable clamp; and  
a guard member connected to and extending outwardly from a second end of the support member to deflect grass clippings projected from the head of the grass trimming device.
2. (previously presented) The guard of claim 1 wherein the support member has a means for adjusting the distance between the guard member and the shaft.
3. (previously presented) The guard of claim 1 wherein the support member further comprises a pair of support members that are spaced in parallel relation extending beyond the shaft on opposite sides of the shaft.
4. (previously presented) The guard of claim 1 wherein the guard member is made of flexible material.
5. (previously presented) The guard of claim 1 wherein the guard is positioned at a 90 degree angle to the shaft of the grass trimming device.

6. (previously presented) A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end, comprising:  
a releaseable clamp slidably connected to the shaft;  
a support member slidably connected within the releasable clamp;  
a flexible brush member connected to and extending outwardly from a second end of the support member to deflect grass clippings projected from the head; and  
a means for adjusting the distance between the guard member and the shaft of the grass trimming device;  
wherein the flexible brush member is positioned at a 90 degree angle to the shaft.

7. (previously presented) The guard of claim 6 wherein the support member is slidably connected to the shaft.

8. (previously presented) The guard of claim 6 wherein the support member further comprises a pair of support members that are spaced in parallel relation extending beyond the shaft on opposite sides of the shaft.

9. (previously presented) The guard of claim 6 wherein the guard member is made of a flexible material.

10. (cancelled).

11. (previously presented) A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end comprising:  
a support member connected to the shaft at a first end of the support member;

a flexible brush member connected to a second end of the support member to deflect grass clippings projected from the head; and

wherein the flexible brush member is positioned at a 90° angle to the shaft.

12. (previously presented) The guard of claim 11 wherein the support member is slidably connected to the shaft.

13. (previously presented) The guard of claim 11 wherein the support member has a means for adjusting the distance between the guard member and the shaft.

14. (previously presented) The guard of claim 11 wherein the support member further comprises a pair of support members that are spaced in parallel relation extending beyond the shaft on opposite sides of the shaft.

15. (cancelled)

16. (previously presented) The guard of claim 6 wherein the adjustable means is a plurality of holes that are used to adjust the vertical distance between the guard member and the shaft.

#### IX. Evidence Appendix

None.

#### X. Related Proceedings Appendix

None.